`IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In Re Application of:

Wiechers, et al.

Serial No.: 10/635,467

Filed: August 7, 2003

Group Art Unit: 2625

Examiner: Rodriguez, Lennin

Docket No. 200207420-1

For: **Managing Workflow In A Commercial Printing Environment With Pre-Submittal High Performance Automated Remote Proofing**

APPEAL BRIEF UNDER 37 C.F.R. § 41.37

Mail Stop: Appeal Brief-Patents
Commissioner for Patents
P.O. Box 1450
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Sir:

This Appeal Brief under 37 C.F.R. § 41.37 is submitted in support of the Notice of Appeal filed April 10, 2008, responding to the Final Office Action mailed December 13, 2007.

It is not believed that extensions of time or fees are required to consider this Appeal Brief. However, in the event that additional extensions of time are necessary to allow consideration of this paper, such extensions are hereby petitioned under 37 C.F.R. § 1.136(a), and any fees required therefor are hereby authorized to be charged to Deposit Account No. 08-2025.

I. Real Party in Interest

The real party in interest is Hewlett-Packard Development Company, LP, a limited partnership established under the laws of the State of Texas and having a principal place of business at 20555 S.H. 249 Houston, TX 77070, U.S.A. (hereinafter "HPDC"). HPDC is a Texas limited partnership and is a wholly-owned affiliate of Hewlett-Packard Company, a Delaware Corporation, headquartered in Palo Alto, CA. The general or managing partner of HPDC is HPQ Holdings, LLC.

II. Related Appeals and Interferences

There are no known related appeals or interferences that will affect or be affected by a decision in this Appeal.

III. Status of Claims

Claims 7 and 11 have been canceled leaving claims 1-6, 8-10, and 12-15 remaining. Each of those claims stand finally rejected. No claims have been allowed. The final rejections of claims 1-6, 8-10, and 12-15 are appealed.

IV. Status of Amendments

This application was originally filed on August 7, 2003, with eleven (11) claims. In a Response filed October 2, 2007, Applicant amended claims 1, 6, and 8-10, added new claims 12-15, and canceled claims 7 and 11.

All of the above-identified amendments have been entered and no other amendments have been made to any of claims 1-6, 8-10, and 12-15. The claims in the attached Claims Appendix (see below) reflect the present state of those claims.

V. Summary of Claimed Subject Matter

The claimed inventions are summarized below with reference numerals and references to the written description ("specification") and drawings. The subject matter described in the following appears in the original disclosure at least where indicated, and may further appear in other places within the original disclosure.

Independent claim 1 describes a method of managing workflow in a commercial printing environment including a designer location and a print service provider location. The method of claim 1 comprises creating at the designer location a print job to be printed by the print service provider location. *Applicant's specification*, pages 6-7, paragraph 0020; Figure 1, item 100. The method of claim 1 further comprises creating a job ticket at the designer location that specifies production devices of the print service provider to be used to process said print job and processing instructions for the print service provider location. *Applicant's specification*, page 7, paragraph 0021; Figure 1, item 104. The method of claim 1 further comprises an automated preflight module at the designer location automatically establishing a link to the print service provider location and obtaining updated device configuration information from the print service provider location concerning the production devices specified in said job ticket. *Applicant's specification*, pages 8-9, paragraph 0027; Figure 1, item 106. The method of claim 1 further comprises said automated preflight module automatically performing

an automated remote proofing by (i) comparing said job ticket with the obtained device configuration information to determine whether all required elements for successful processing of said print job are present and (ii) checking said print job and said job ticket for errors. *Applicant's specification*, page 9, paragraph 0027. The method of claim 1 further comprises generating at the designer location a press ready file that encapsulates both said print job and said job ticket. *Applicant's specification*, page 12, paragraph 0041; Figure 1, item 118. The method of claim 1 further comprises submitting said press ready file to the print service provider location via an electronic network. *Applicant's specification*, page 12, paragraph 0043; Figure 1, item 120. The method of claim 1 further comprises performing at the print service provider least one of automated printing, finishing, packaging and shipping using said press ready file. *Applicant's specification*, pages 17-18, paragraphs 0065-0070; Figure 1, items 138-144.

Independent claim 6 describes a computer-readable medium that stores a program product for managing workflow in a commercial printing environment including a designer location and a print service provider location. The product causes a machine to perform creating at the designer location a print job to be printed by the print service provider location. *Applicant's specification*, pages 6-7, paragraph 0020; Figure 1, item 100. The product further causes a machine to perform creating a job ticket at the designer location that specifies production devices of the print service provider to be used to process said print job and processing instructions for the print service provider location. *Applicant's specification*, page 7, paragraph 0021; Figure 1, item 104. The product further causes a machine to perform automatically establishing a link to the print service provider location and obtaining updated device configuration information from

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the print service provider location concerning the production devices specified in said job ticket. *Applicant's specification*, pages 8-9, paragraph 0027; Figure 1, item 106. The product further causes a machine to perform automatically performing an automated remote proofing by (i) comparing said job ticket with the obtained device configuration information to determine whether all required elements for successful processing of said print job are present and (ii) checking said print job and said job ticket for errors. *Applicant's specification*, page 9, paragraph 0027. The product further causes a machine to perform generating at the designer location a press ready file for provision to the print service provider location, the press ready file encapsulating both said print job and said job ticket. *Applicant's specification*, page 12, paragraph 0041; Figure 1, item 118. The product further causes a machine to perform submitting said press ready file to the print service provider location via an electronic network. *Applicant's specification*, page 12, paragraph 0043; Figure 1, item 120.

VI. Grounds of Rejection to be Reviewed on Appeal

The following ground of rejection is to be reviewed on appeal:

Claims 1-6, 8-10, and 12-15 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over *Laverty, et al.* ("Laverty," U.S. Pat. No. 6,429,947) in view of *Schorr, et al.* ("Schorr," U.S. Pat. No. 6,608,697) and *Lahey, et al.* ("Lahey," U.S. Pat. No. 6,587,217).

VII. Arguments

The Appellant respectfully submits that Applicant's claims are not obvious under 35 U.S.C. § 103 and respectfully requests that the Board of Patent Appeals reverse the final rejections for the reasons discussed below.

Claim Rejections - 35 U.S.C. § 103(a)

Claims 1-6, 8-10, and 12-15 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over *Laverty, et al.* ("Laverty," U.S. Pat. No. 6,429,947) in view of *Schorr, et al.* ("Schorr," U.S. Pat. No. 6,608,697) and *Lahey, et al.* ("Lahey," U.S. Pat. No. 6,587,217). Applicant respectfully traverses.

As has been acknowledged by the Court of Appeals for the Federal Circuit, the U.S. Patent and Trademark Office ("USPTO") has the burden 35 U.S.C. § 103 to establish obviousness by showing objective teachings in the prior art or generally available knowledge of one of ordinary skill in the art that would lead that individual to the claimed invention. *In re Fine*, 837 F.2d 1071, 1074, 5 U.S.P.Q. 2d 1596, 1598 (Fed. Cir. 1988). The key to supporting an allegation of obviousness under 35 U.S.C. § 103 is

the clear articulation of the reasons why the Examiner believes that claimed invention would have been obvious. *See* MPEP § 2141. As stated by the Supreme Court, "[r]ejections on obviousness cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness." *KSR v. Teleflex*, 550 U.S. at ___, 82 USPQ2d at 1396 (quoting *In re Kahn,* 441 F.3d 977, 988, 78 USPQ2d 1329, 1336 (Fed. Cir. 2006)) .

In the present case, the Examiner has not established that Applicant's claims are obvious in view of the prior art. Applicant discusses those claims in the following.

Applicant's independent claim 1 provides (emphasis added):

1.   A method of managing workflow in a commercial printing environment including a designer location and a print service provider location, said method comprising:

creating at the designer location a print job to be printed by the print service provider location;

creating a job ticket at the designer location that specifies production devices of the print service provider to be used to process said print job and processing instructions for the print service provider location;

an automated preflight module at the designer location automatically establishing a link to the print service provider location and obtaining updated device configuration information from the print service provider location concerning the production devices specified in said job ticket;

said automated preflight module automatically performing an automated remote proofing by (i) comparing said job ticket with the obtained device configuration information to determine whether all

required elements for successful processing of said print job are present and (ii) checking said print job and said job ticket for errors;

generating at the designer location a press ready file that encapsulates both said print job and said job ticket;

submitting said press ready file to the print service provider location via an electronic network; and

performing at the print service provider least one of automated printing, finishing, packaging and shipping using said press ready file.

A. No Disclosure of Generating a Press Ready File that "Encapsulates both [a] Print Job and [a] Job Ticket"

In the final Office Action, the Examiner argued that Laverty discloses "generating at the designer location a press ready file that encapsulates both said print job and said job ticket". For support of that position, the Examiner cited column 10, lines 50-61 of the Laverty reference, which provide as follows:

> FIG. 3 shows a block diagram 300 of a generalized series of steps used in creating a print order. A customer 302 contacts a web site via the computer 304. The customer inputs data on the web site according to data prompts needed to generate the customer's desired print job. The system creates a Print Ready File (PRF), as shown in element 305. The PRF 306 is shown to the customer 302 for on-screen proofing 308 of various elements comprising the product. Once the order is approved, step 310 shows the order being sent to the printer. The PRF 306 is thereafter sent to printer as a print order 312, and the manufacturing (or printing) process begins.

As can be readily appreciated from the above excerpt, Laverty does not in fact describe any "job ticket" or state that such a job ticket is "encapsulated" along with a print job in a press ready file. Although Laverty identifies a Print Ready File, Laverty does not state that it encompasses a print job and a job ticket.

B.   No Disclosure of an "Automated Preflight Module at a Designer Location Automatically Establishing a Link to the Print Service Provider Location and Obtaining Updated Device Configuration Information from the Print Service Provider Location Concerning the Production Devices Specified in Said Job Ticket"

In the final Office Action, the Examiner acknowledged that Laverty does not disclose "an automated preflight module at the designer location automatically establishing a link to the print service provider location and obtaining updated device configuration information from the print service provider location concerning the production devices specified in said job ticket". To account for that shortcoming, the Examiner turned to the Schorr reference, which was alleged to disclose that limitation. Applicant disagrees. Applicant discusses different portions of the above limitation in the following three subsections.

1.   "Automatically Establishing a Link to the Print service provider Location"

As a first matter, Schorr does not disclose an automated preflight module at the designer location "automatically establishing a link to the print service provider location". Regarding column 3, lines 61-67 and column 4, lines 29-37 of the Schorr reference,

which were identified by the Examiner, those portions of Schorr's disclosure describe a preflight system 101 that print vendors 117 and a print buyer 119 can use. Schorr does not state, however, that the preflight system 101 automatically establishes a link to the print vendors 117.

Regarding the Examiner's argument in the Advisory Action that automatically establishing a link to the print service provider location is disclosed by Schorr because Schorr teaches the print buyer 119 requesting the services of the print vendors 117, a user manually directing his or her web browser to a web site of a print vendor does not comprise an "automated preflight module automatically establishing a link". First, as described in the next subsection, Schorr does not indicate that the print buyer 119 comprises an automated preflight module. Second, a link is not "automatically" formed when a user affirmatively acts to establish that link.

2. An Automatic Preflight Module "at the Designer Location"

Furthermore, the preflight system 101 is clearly not "at the designer location". As shown in Figure 1A, the preflight system 101 is separate from the print buyer 119 and his client machine 121. Schorr also explicitly states that the preflight system 101 is embodied on one or more servers. *Schorr*, column 3, lines 51-58. Although Schorr describes discrete modules contained within the preflight system 101 that are downloaded to the client machine 121, Schorr does *not* state that the entire preflight system is downloaded to that machine.

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3. **"Obtaining Updated Device Configuration Information from the Print Service Provider Location Concerning the Production Devices Specified in Said Job Ticket"**

As a second matter, Schorr does not actually disclose an automated preflight module "obtaining updated device configuration information from the print service provider location concerning the production devices specified in said job ticket". Column 6, lines 41-65 of the Schorr reference, which were cited by the Examiner, say nothing about a production device "specified in said job ticket". Indeed, Schorr does not even mention a job ticket.

C. **No Disclosure of an Automated Preflight Module "Automatically Performing an Automated Remote Proofing by (i) Comparing [a] Job Ticket with the Obtained Device Configuration Information to Determine whether all required Elements for Successful Processing of [a] Print Job are Present and (ii) Checking said Print Job and said Job Ticket for Errors"**

The Examiner further acknowledged in the final Office Action that Laverty does not disclose "said automated preflight module automatically performing an automated remote proofing by (i) comparing said job ticket with the obtained device configuration information to determine whether all required elements for successful processing of said print job are present and (ii) checking said print job and said job ticket for errors". To account for that shortcoming, the Examiner again turned to the Schorr reference, which was alleged to disclose that action. Applicant disagrees. Applicant discusses different portions of the above limitation in the following two subsections.

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1.   "Comparing [a] Job Ticket with the Obtained Device Configuration Information to Determine whether all required Elements for Successful Processing of [a] Print Job are Present"

Regarding an automated preflight module performing automated remote proofing by "comparing said job ticket with the obtained device configuration information to determine whether all required elements for successful processing of said print job are present", Applicant notes that Applicant explicitly claimed that the automated preflight module is located "at the designer location". Schorr's analyzer 111, which is described in column 3, lines 10-29 cited by the Examiner, is not located at the designer location. Instead, the analyzer 111 is located on one or more servers separate from the print buyer 119 and his client machine 121. *Schorr*, column 3, lines 51-58; Figure 1A. Applicant further notes that, although Schorr describes downloading various modules to the client machine 121, the analyzer 111 is not one of them. Moreover, Applicant notes that the analyzer is not described as comparing a "job ticket" with obtained device configuration information. Instead, the analyzer 111 is merely described as comparing "document elements" with information listed in a printer profile.

Regarding the Examiner's argument in the Advisory Action that Schorr's analyzer 111 is at the designer location because it is used by a client via a network, such "use" does not mean that the analyzer is "at" the client's location. To the contrary, as is explicitly shown in Figure 1A, the analyzer 111 comprises part of a preflight system 101 that clearly is separate from the client machine 121. That the client can obtain information from the analyzer 111 via the Internet does not change the fact that the software that comprises the analyzer is stored on remote servers of the preflight system

101 or the fact that that software is executed on those remote servers and _not_ on the client machine 121.

2. "Checking said Print Job and said Job Ticket for Errors"

Regarding an automated preflight module performing automated remote proofing by "checking said print job and said job ticket for errors", Applicant notes that Schorr does not actually disclose an automated preflight module performing automated remote proofing by checking a print job and a job ticket for errors. Again, as mentioned above, Schorr does not even discuss job tickets.
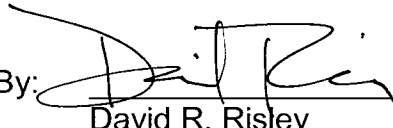
D. Conclusion

In view of the above, it is clear that the applied references do not render Applicant's claim 1 or its dependents obvious. Applicant respectfully submits that independent claim 6 and its dependents are also non-obvious for similar reasons.

VIII. Conclusion

In summary, it is Applicant's position that Applicant's claims are patentable over the applied prior art references and that the rejection of these claims should be withdrawn. Appellant therefore respectfully requests that the Board of Appeals overturn the Examiner's rejection and allow Applicant's pending claims.

Respectfully submitted,

By:

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Claims Appendix under 37 C.F.R. § 41.37(c)(1)(viii)

The following are the claims that are involved in this Appeal.

1.   A method of managing workflow in a commercial printing environment including a designer location and a print service provider location, said method comprising:

creating at the designer location a print job to be printed by the print service provider location;

creating a job ticket at the designer location that specifies production devices of the print service provider to be used to process said print job and processing instructions for the print service provider location;

an automated preflight module at the designer location automatically establishing a link to the print service provider location and obtaining updated device configuration information from the print service provider location concerning the production devices specified in said job ticket;

said automated preflight module automatically performing an automated remote proofing by (i) comparing said job ticket with the obtained device configuration information to determine whether all required elements for successful processing of said print job are present and (ii) checking said print job and said job ticket for errors;

generating at the designer location a press ready file that encapsulates both said print job and said job ticket;

submitting said press ready file to the print service provider location via an electronic network; and

performing at the print service provider least one of automated printing, finishing, packaging and shipping using said press ready file.

2.   A method of managing workflow according to claim 1, wherein after said step of submitting, said method further comprises a step of verifying, at said print service provider location, that said press ready file will be produced at said print service provider location as designed at the designer location and, if not, correcting said press ready file to ensure production substantially as designed.

3.   A method of managing workflow according to claim 1, wherein said step of performing automated remote proofing further comprises printing on a printer at the designer location, a high resolution proof representing the final output of the press ready file.

4.   A method of managing workflow according to claim 3, wherein said step of performing automated remote proofing further comprises receiving at the designer location an electronic indication of approval of said high resolution proof from a designer or customer.

5.   A method of managing workflow according to claim 3, wherein said printer at a designer location receives color management information of a selected printing device at the print service provider location and prints the high resolution proof in accordance with such information.

6.   A computer-readable medium that stores a program product for managing workflow in a commercial printing environment including a designer location and a print service provider location, said product comprising machine-readable program code for causing, when executed, a machine to perform the following method steps:

creating at the designer location a print job to be printed by the print service provider location;

creating a job ticket at the designer location that specifies production devices of the print service provider to be used to process said print job and processing instructions for the print service provider location;

automatically establishing a link to the print service provider location and obtaining updated device configuration information from the print service provider location concerning the production devices specified in said job ticket;

automatically performing an automated remote proofing by (i) comparing said job ticket with the obtained device configuration information to determine whether all required elements for successful processing of said print job are present and (ii) checking said print job and said job ticket for errors;

generating at the designer location a press ready file for provision to the print service provider location, the press ready file encapsulating both said print job and said job ticket; and

submitting said press ready file to the print service provider location via an electronic network.

7.   (Canceled)

8.   A computer-readable medium according to claim 6, wherein said step of performing automated remote proofing further comprises printing on a printer at the designer location, a high resolution proof representing the final output of the press ready file.

9.   A computer-readable medium according to claim 8, wherein said step of performing automated remote proofing further comprises receiving at the designer location an electronic indication of approval of said high resolution proof from a designer or customer.

10.   A computer-readable medium according to claim 8, wherein said printer at a designer location receives color management information of a selected printing device at the print service provider location and prints the high resolution proof in accordance with such information.

11.   (Canceled)

12.   The method according to claim 1, wherein automatically performing an automated remote proofing comprises generating a remote proof file that accurately reflects a final output of said print job that should be produced by the print service provider location.

13.   The method according to claim 12, wherein generating a press ready file further comprises encapsulating said remote proof file in said press ready file.

14.   The computer-readable medium according to claim 6, wherein automatically performing an automated remote proofing comprises generating a remote proof file that accurately reflects a final output of said print job that should be produced by the print service provider location.

15.   The computer-readable medium according to claim 14, wherein generating a press ready file further comprises encapsulating said remote proof file in said press ready file.

Evidence Appendix under 37 C.F.R. § 41.37(c)(1)(ix)

There is no extrinsic evidence to be considered in this Appeal. Therefore, no evidence is presented in this Appendix.

<u>Related Proceedings Appendix under 37 C.F.R. § 41.37(c)(1)(x)</u>

There are no related proceedings to be considered in this Appeal. Therefore, no such proceedings are identified in this Appendix.